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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,749	11/29/2001	Hideki Kobayashi	TSL1685	3709

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,749

Applicant(s)

KOBAYASHI ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 29 November 2001.

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1 to 20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1 to 20 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some * c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adachi et al. in view of Hartmann et al. and/or GB 2 001 303 A.

Adachi et al. teach a one package RTV silicone composition containing each of the claimed components (A), (B), (C) and (E), meeting the preferred embodiments of claims 2 to 7 and 12 to 14. Note for instance columns 5 and 6, which teach the amounts of each component, and note particularly the examples which include Polymer B, containing a blend of hydroxyl and non-hydroxyl terminated siloxanes meeting the viscosity of claim 3 and the limitations of claims 15 and 16. The bottom of column 9 teaches the addition of organic solvents to this composition. While the boiling point of the solvent is not taught, one having ordinary skill in the art would have been motivated to select a solvent having a boiling point within the range claimed in an effort to eliminate or reduce any premature evaporation of the solvent. Also note that many conventional and common solvents used in silicone RTV compositions, such as xylene and toluene, meet this limitation. Adjusting the amount of such solvent would have been well within the skill of the ordinary artisan, in an effort to optimize the properties thereof. In this manner, the teachings of Adachi et al. meet or render obvious each of the claimed components (A) to (C) and (E) to (G).

Column 5 teaches the addition of a surface treated silica filler, but patentees fail to teach the specific filler limitations as found in instant component (D).

Hartmann et al. teach silanized silica meeting the limitations of component (D). See for instance the Example on column 2, and claim 1 in Hartmann et al. This silica is used as an additive in silicone RTV compositions, and offers various benefits over traditional silicas. See the bottom of column 1 to column 2.

GB 2 001 303 A teaches hydrophobized silicas that can be used as fillers in RTV silicone compositions. See page 1, which teaches the properties of the silica, meeting the requirement of claimed component (D). Page 4 teaches various benefits associated with such a silica.

Thus one having ordinary skill in the art would have been motivated to use the silica of Hartmann et al. and/or the silica of GB 2 001 303 A, i.e. one meeting the requirements of claimed component (D), in the composition of Adachi et al. in an effort to take advantage of the benefits and properties thereof. In view of this, the instant claims are rendered obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

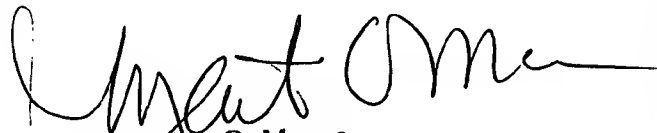
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
November 1, 2002